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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,274	09/30/2002	James Feine	USI-35	5685
23508	7590	12/13/2004	EXAMINER	
LUNDEEN & DICKINSON, LLP			MANAHAN, TODD E	
PO BOX 131144			ART UNIT	
HOUSTON, TX 77219-1144			PAPER NUMBER	

3732

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/065,274	Applicant(s) FEINE, JAMES	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to an ultrasonic scaler and footswitch, classified in class 433, subclass 101.
- II. Claims 16-19, drawn to business method and inventory, classified in class 705, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process, such as door-to-door direct sales with no ordering or shipping required.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Applicant's election with traverse of Group I, claims 1-15 in the reply filed on 01 September 2004 is acknowledged. The traversal is on the ground(s) that the inventions are not

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distinct. This is not found persuasive because, as set forth above, the apparatus and the method are distinct because the apparatus can be used in a materially different method. Applicant argues that because each feature of apparatus claim 6 is incorporated into claims 16 and 19, the inventions are not distinct. First it is to be noted that apparatus claim 6 requires a capacitor which is not recited in either claim 16 or 19. Furthermore, even if claims 16 and 19 included all the elements of claim 6, restriction is proper if the process for using the product as claimed can be practiced with another materially different product **or (2) the product as claimed can be used in a materially different process of using that product** (MPEP § 806.05(h)). Though the process as claimed may not be practiced with a material different product, the product clearly can be used in a materially different process. The example cited by the examiner of door-to-door direct sales being just one materially different process. Another example of a materially different process would be using the scaler of Group I to scale a patient's teeth, which is clearly a different process or method than that recited in claim 16. If applicant still feels that the marketing method and inventory are an obvious method of marketing and inventorying the device, and thus not distinct inventions, it is respectfully requested that it be stated as such for the record.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3 there exists an inconsistency in the language of the claim thus making its scope unclear. In lines 2 and 3, the footswitch is only functionally recited, i.e. "for coupling a power level controlling footswitch", thus indicating that the claim is directed to the connector and not the combination with the footswitch. However lines 3-5 positively recite part of the footswitch, i.e. "the footswitch connector ... couples a second potentiometer in the footswitch to the dental generation unit", thus indicating that the claim is directed to the combination of the footswitch and the connector. As such it is unclear whether applicant intends to claim the footswitch as part of the invention. Applicant is hereby required to indicate whether the claim is intended to be drawn to the connector or the combination of the connector and the footswitch and make the language thereof consistent with this intent. For examination purposes, claim 3 will be considered as being drawn to just the connector with the footswitch only functionally recited.

In claim 12 there exists an inconsistency in the language of the preamble and that of the body of the claim, thus making its scope unclear. In the preamble, the dental scaler is only functionally recited, i.e. "for use with an ultrasonic dental scaler", thus indicating that the claim is directed to the subcombination, a footswitch. However lines 3-5 positively recite the dental scaler as part of the invention, i.e. "a footswitch connector coupled between the footswitch and the ultrasonic dental scaler" and "the footswitch connector connects the circuitry in the dental scaler to a first potentiometer", thus indicating that the claim is directed to the combination of the footswitch and the dental scaler. As such it is unclear whether applicant intends to claim to be

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directed to the combination or the subcombination. Applicant is hereby required to indicate whether the claim is intended to be drawn to the subcombination only, the footswitch, or the combination of the dental scaler and the footswitch and make the language thereof consistent with this intent. Claim 13 also appears to be drawn to the combination of the footswitch and the dental scaler by reciting the potentiometer therein. For examination purposes, claim 12 will be considered as being drawn to the combination of a dental scaler and the footswitch.

Also in claim 12, line 5, "the circuitry in the ultrasonic dental scaler" lacks a prior antecedent.

Claim 15 has nearly identical problems as claim 12, including lack of antecedent basis and should be corrected in a similar manner. It is also unclear whether applicant intends to claim the first and second potentiometers as part of the invention. For examination purposes, claim 15 will be considered as directed to the combination of the footswitch, the ultrasonic scaler, and the two potentiometers.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gofman et al. (United States Patent No. 6,241,520).

Gofman et al. disclose an ultrasonic dental scaler comprising a dental generator unit comprising circuitry for producing a base resonance signal; a handpiece connector for coupling a handpiece to the generator unit and a passive circuit element which adjusts the base frequency of the resonance signal to a second frequency matching the frequency of the handpiece. The dental

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generator unit includes a first potentiometer and a footswitch connector and a footswitch. The passive circuit element is a capacitor in the handpiece connector.

Claims 1-5, 7-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharp (United States Patent No. 6,190,167).

Sharp discloses an ultrasonic dental scaler comprising a dental generator unit 4 comprising circuitry for producing a base resonance signal; a handpiece connector 2 for coupling a handpiece to the generator unit and a passive circuit element which adjusts the base frequency of the resonance signal to a second frequency matching the frequency of the handpiece. The dental generator unit includes a first potentiometer and a footswitch connector and a footswitch. The passive circuit element is a capacitor in the dental generator unit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gofman et al.

Gofman et al. disclose the claimed invention except for the capacitor being in the handpiece connector instead of the generator unit (claim 7) and the potentiometer being in the generator unit instead of the footswitch (claim 14). It would have been obvious to one having ordinary skill in the art at the time the invention was made put the capacitor in the generator unit (claim 7) instead of the handpiece connector and/or the potentiometer in the footswitch instead of

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the generator unit (claim 14), since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Allowable Subject Matter

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 15, as understood, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

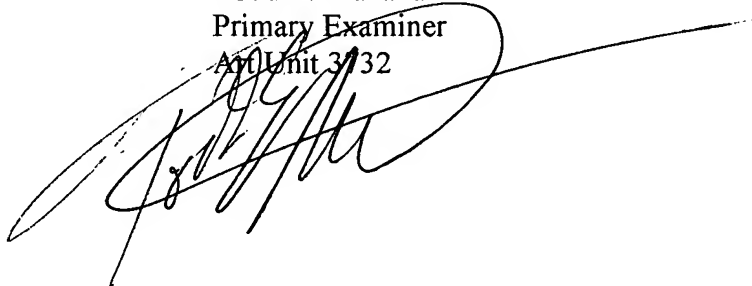
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
9 December 2004

A large, stylized handwritten signature in black ink, likely belonging to Todd E. Manahan, is written over the printed name and title. The signature is fluid and cursive, with a long horizontal stroke extending to the right.